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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/925,585 | 08/09/2001 | Lane Thomas Holloway | AUS9-2001-0253-US1 | 2884 |
| 47959 | 7590 | 08/10/2005 | | |
| IBM CORP. (AVE) C/O LAW OFFICE OF ANTHONY ENGLAND PO BOX 5307 AUSTIN, TX 78763-5307 | | | EXAMINER PATEL, MANGLESH M | |
| | | | ART UNIT 2178 | PAPER NUMBER |

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,585

Applicant(s)

HOLLOWAY ET AL.

Examiner

Manglesh M. Patel

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 09, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: to the application filed on August 9, 2001.
2. Claims 1-21 are pending. Claims 1, 8 and 15 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.
5. Claims 8-14 are rejected because the claimed invention is directed to non-statutory subject matter. The claims describe a computer program product but fail to include a computer readable medium.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 8, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majoor (U.S. Pub 2002/0029154) in view of Callender (U.S. Pub 2002/0119433).

Regarding Independent claim 1, Majoor discloses *a method for generating a survey for a client on a network, the method comprising the steps of: Providing a survey document having questions and answers in a certain format for delivery to a client on a network* (paragraph 14 & paragraph 24, Wherein a client is connected to a rule server for receiving questions and answers. Based on previous response new questions are dynamically determined by the rule server). Majoor fails to explicitly teach the branching format used for the questions based on previous answers. Callender teaches *the format defining branches for the questions, wherein whether a first one of the questions branches to a second one of the questions or to a third one of the questions, depends on an answer for the first question* (paragraph 41, Wherein questions are described using a 2 dimensional tree structure with multiple nodes and branches). In addition Callender teaches *providing instructions for delivery to the client on the network, which cause the client to display on a user interface certain ones of the questions, including the first one of the questions, and branch to and display on*

the user interface the second or third one of the questions responsive to an answer received for the first question (paragraph 31, Wherein the interviewee can traverse through the two dimensional tree structure of the interview based on the answers provided). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a branching structure for presenting questions based on previous answers. The motivation for doing so would have been to save time by asking relevant questions based on the previous answers. Therefore it would have been obvious to combine the teachings of Callender with Majoor for the benefits of saving time by conducting a survey based on previous responses by excluding irrelevant questions.

Regarding Independent claim 8, the claim is for a computer program product performing the method of claim 1, and is similarly rejected under the same rationale.

Regarding Independent claim 15, the claim is for a server performing the method of claim 1, and is similarly rejected under the same rationale.

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8. Claims 2, 4, 7, 9, 11, 14, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majoor (U.S. Pub 2002/0029154) in view of Callender (U.S. Pub 2002/0119433) further in view of Gupta (U.S. Pub 2002/0184265).

Regarding Dependant claim 2, Majoor teaches a rule based system for question handling through an electronic interface (paragraph 5, lines 1-5). Majoor fails to teach the use of markup language with tags to describe the questions and answers in a document. Callender teaches the branches associated with the questions (paragraph 41, Wherein questions are described using a 2 dimensional tree structure with multiple nodes and branches). Callender fails to teach the use of markup language for describing the questions and answers. Gupta teaches *wherein according to the certain format of the survey document the questions and answers are defined as data elements included in the survey document as strings of text surrounded by text markups, including tags, that describe the data elements and wherein the question branches are defined as associations among the data elements* (paragraph 19, Wherein extensible markup language with tag definitions within a DTD are used for a question/answer generator). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a markup language to define the questions and answers for a survey. The motivation for doing so would have been to increase the portability for updating question/answers by limiting the need for redesign. Therefore it would have been obvious to combine the teachings of Gupta with Callender and

Majoor for the benefits of allowing a more portable survey system capable of using previous answers for dynamically determining questions.

Regarding Dependant claim 4, Majoor fails to teach the use of a document type definition file. Gupta teaches *a method comprising the step of: providing a data type definition file for delivery to the client on the network, wherein the instructions include instructions for causing the client validate the data elements responsive to the document type definition file* (paragraph 24, Wherein a DTD is used to define the format of the document. Questions and answers are separated by the DTD, by elements and attributes respectively). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a document type definition file for presenting questions/answers. The motivation for doing so would have been to increase the portability for updating question/answers by limiting the need for redesign. Therefore it would have been obvious to combine the teachings of Gupta with Callender and Majoor for the benefits of allowing a more portable survey system capable of using previous answers for dynamically determining questions.

Regarding Dependant claim 7, Majoor fails to teach the return of survey results in a markup language with tags and data elements. Gupta teaches *wherein the programming instructions include instructions for causing the client to return survey results to a server as a document defining the answers as data elements*

included in the survey document as strings of text surrounded by text markups, including tags, wherein the text markups describe the data elements (paragraph 24, Wherein a markup language is used to describe the answer/questions with tags and data elements).

Regarding Dependant claim 9, the claim is for a computer program product performing the method of claim 2, and is similarly rejected under the same rationale.

Regarding Dependant claim 11, the claim is for a computer program product performing the method of claim 4, and is similarly rejected under the same rationale.

Regarding Dependant claim 14, the claim is for a computer program product performing the method of claim 7, and is similarly rejected under the same rationale.

Regarding Dependant claim 16, the claim is for a server performing the method of claim 2, and is similarly rejected under the same rationale.

Regarding Dependant claim 21, the claim is for a server performing the method of claim 7, and is similarly rejected under the same rationale.

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9. Claims 3, 5-6, 10, 12-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majoor (U.S. Pub 2002/0029154) in view of Callender (U.S. Pub 2002/0119433) further in view of Gupta (U.S. Pub 2002/0184265) further in view of Plantec (U.S. 6,826,540).

Regarding Dependant claim 3, Majoor teaches a rule based system for question handling through an electronic interface (paragraph 5, lines 1-5). Majoor fails to teach the parsing of elements into a data array for defining questions and answers. Callender teaches the branches associated with the questions (paragraph 41, Wherein questions are described using a 2 dimensional tree structure with multiple nodes and branches). Callender fails to teach the parsing of elements into an array. Gupta teaches the use of markup language with tags defining a definition file (paragraph 19 & 24). Gupta fails to teach the use of an array for collecting parsed data representing answers/questions. Plantec teaches *wherein the instructions comprise instructions for causing the client to parse the data elements from the survey document into data arrays having cross-references defining associations among questions and answers* (column 38, lines 33-48, Wherein the survey results consisting of questions/answers are stored in an array). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of an array for storing the survey results. The motivation for doing so would have been to provide a more efficient data collection method for the conversion of the information into a form useful to the survey sponsor. Therefore it would have been obvious to combine the

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teachings of Plantec with Gupta, Callender and Majoor for the benefits of allowing a more efficient and portable survey system capable of using previous answers for dynamically determining questions.

Regarding Dependant claim 5, Majoor fails to teach the use of a browser for displaying the received information. Plantec teaches *wherein the instructions are included in a document that includes information for displaying by a browser running on the client and directions for how the browser should display the information, and the instructions include instructions in an object oriented, interpreted, dynamic programming language* (column 15, lines 1-11, Wherein a internet browser module is used to transfer information. The module may be coded in many different high-level languages such as C, C++, Java or Pascal). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a browser described in an object oriented language. The motivation for doing so would have been to increase the portability for display within a browser by limiting the need for redesign. Therefore it would have been obvious to combine the teachings of Plantec with Gupta, Callender and Majoor for the benefits of allowing a more efficient and portable survey system capable of using previous answers for dynamically determining questions.

Regarding Dependant claim 6, Majoor fails to Explicitly teach the use of Java programming language for describing the data displayed within a browser.

Plantec explicitly teaches *wherein the programming language includes Java* (column 15, lines 6-11, *Wherein The module may be coded in many different high-level languages such as C, C++, Java or Pascal*). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a browser described in java programming language. The motivation for doing so would have been to increase the portability for display within a browser by limiting the need for redesign. Therefore it would have been obvious to combine the teachings of Plantec with Gupta, Callender and Majoor for the benefits of allowing a more efficient and portable survey system capable of using previous answers for dynamically determining questions.

Regarding Dependant claim 10, the claim is for a computer program product performing the method of claim 3, and is similarly rejected under the same rationale

Regarding Dependant claim 12, the claim is for a computer program product performing the method of claim 5, and is similarly rejected under the same rationale

Regarding Dependant claim 13, the claim is for a computer program product performing the method of claim 6, and is similarly rejected under the same rationale

Regarding Dependant claim 17, the claim is for a server performing the method of claim 3, and is similarly rejected under the same rationale

Regarding Dependant claim 18, the claim is for a server performing the method of claim 4, and is similarly rejected under the same rationale

Regarding Dependant claim 19, the claim is for a server performing the method of claim 5, and is similarly rejected under the same rationale

Regarding Dependant claim 20, the claim is for a server performing the method of claim 6, and is similarly rejected under the same rationale.

Other Prior Art Cited

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kelly (U.S. Pub 2003/0088452) discloses "Survey Methods For Handheld Computers"
- Nelson (U.S. Pub 2002/0120491) discloses "Interactive Survey And Data Management Method And Apparatus"
- Brookler et al. (U.S. Pub 2002/0007303) discloses "System For Conducting Electronic Surveys"

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel

Patent Examiner

August 1, 2005



CESAR PAULA
PRIMARY EXAMINER